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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,073	12/16/2003	Michael C. Swiader	4426-0102P	9011
2292	7590	07/24/2006		EXAMINER
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			GOKHALE, SAMEER K	
			ART UNIT	PAPER NUMBER
			2629	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,073	SWIADER, MICHAEL C.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sameer K. Gokhale	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 February 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 18, the claim contains the recitation of "wherein the base docking station further includes at least one of a click button, a programmable button, a scroll wheel, a trackball..." on lines 1-3. The enablement of a base docking station having these items is question. Neither the specification or the drawings show that the base docking station can have the above-mentioned items.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-6,8,9,13,14,16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3-6,8,9,13,14, the phrase "wherein the cursor control device is at least one of a trackball, a scroll wheel, and an electrostatic touchpad" on lines 1-3 of

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claim 3, renders the claims indefinite because it is not clear from the disclosed specification that a scroll wheel can act as a cursor control device by itself.

Regarding claim 16-17, the phrase " a wire to communicate input and control data to the external host computing device " on lines 3-4 or claim 16 renders the claims indefinite because it is unclear whether the it is the wire performing the described function or whether it is the "sensing device" on lines 2 of claim 15 which has the exact same described function, or whether the sensing device and the wire are meant to the same.

5. In light of the above rejections under 35 USC 112, the following rejections are based on the claims as best understood by the examiner.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 10, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes (US 6,222,526).

Regarding claim 1, Holmes teaches an ergonomic data input and control device comprising: a housing having a grip portion being contoured to conform to a grip of a

user's hand (Fig. 4 and Fig. 7), said housing further including an upper portion, a central portion and a lower portion (Fig. 4, the device here shows an upper portion at 26, a central portion at 16, and a lower portion at 14); at least one click button being positioned on a front side of the central portion of the housing (Fig. 1, button 32), wherein said at least one click button is positioned on the front side in a position capable of being manipulated by fingers of the user's hand and a rear side of the central portion is contoured to a palm portion of the user's hand (Fig. 7 shows such an arrangement); a cursor control device being integrally positioned within the upper portion of the housing (Fig. 8, trackball 40), wherein said cursor control device is positioned within the upper portion of the housing in a position capable of being manipulated by a thumb of the user's hand (Fig. 7); and at least one programmable button being mounted on an upper face of the upper portion of the housing (Fig. 8, button 34).

Regarding claim 2, Holmes teaches a device wherein said upper portion is tapered to extend outwardly with respect to said central portion of the housing (Fig. 4 shows the upper portion tapering outwardly).

Regarding claims 3 and 4, Holmes teaches a device wherein the cursor control device is at least one of a trackball, a scroll wheel, and an electrostatic touchpad (Fig. 3, ball 40, see col. 4, lines 51-54, where the cursor control device is a trackball).

Regarding claim 10, Holmes teaches a device further comprising a power supply for wireless operation (see col. 4, line 65 to col. 5, line 2, where a power supply is inherent in using a radio transmit function in a free space mode of operation).

Regarding claim 15, Holmes teaches a sensing device integrally formed with said housing for communicating input and control data between the control device and an external host computing device (see col. 4, line 65 to col. 5 line 2, where the radio transmitter is the sensing device).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Rosenberg (US 6,693,626).

Regarding claims 5 and 6, Holmes teaches the limitations of claims 3 and 4 as discussed above, however Holmes does not teach a device where the cursor control

device is a scroll wheel positioned within and protruding from the upper face of the upper portion of the housing.

However, Rosenberg does teach an input device where the cursor control device is a scroll wheel positioned within and protruding from the upper face of the upper portion of the housing (Fig. 5, where there is a scroll wheel 158 on the upper face of the upper portion of the housing).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the scroll wheel of Rosenberg in the device of Holmes in order to add the known functionality of a scroll wheel, which allows a user to scroll up and down a page on the screen, to the device.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Pejic et al. (US 5,956,018) (hereafter, "Pejic").

Regarding claim 7, Holmes teaches the limitations of claims 1 as discussed above, however Holmes does not teach a pair of click buttons being positioned on the front side of the central portion of the housing.

However, Pejic does teach an input device comprising a pair of click buttons being positioned on the front side of the central portion of the housing (Fig. 1A, buttons 20, see col. 4, lines 34-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the additional click buttons of Pejic in the device of

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Holmes in order to have the capability to send more than one input control signal from the central portion of the device.

11. Claims 8, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Rosenberg and in further view of Pejic.

Regarding claim 8, Holmes in view of Rosenberg teaches the limitations of claim 6 as discussed above, however it does not teach a pair of click buttons being positioned on the front side of the central portion of the housing.

However, Pejic does teach an input device comprising a pair of click buttons being positioned on the front side of the central portion of the housing (Fig. 1A, buttons 20, see col. 4, lines 34-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the additional click buttons of Pejic in the device of Holmes in view of Rosenberg, in order to have the capability to send more than one input control signal from the central portion of the device.

Regarding claim 9, Holmes further teaches a device wherein said upper portion is tapered to extend outwardly with respect to said central portion of the housing (Fig. 4 shows the upper portion tapering outwardly).

Regarding claim 13, Holmes further teaches a sensing device integrally formed with said housing for communicating input and control data between the control device

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and an external host computing device (see col. 4, line 65 to col. 5 line 2, where the radio transmitter is the sensing device).

12. Claims 11, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Robinson et al. (US 6,897,833) (hereafter, "Robinson").

Regarding claims 11 and 19, Holmes teaches a hand-held ergonomic data input and control device comprising: a housing having a grip portion being contoured to conform to a grip of a user's hand (Fig. 7), said housing further including an upper portion, a central portion and a lower portion (Fig. 4, the device here shows an upper portion at 26, a central portion at 16, and a lower portion at 14), wherein said upper portion of said housing is tapered to extend outwardly with respect to said central portion of the housing (Fig. 4 shows the upper portion tapering outwardly); at least one click button being positioned on a front side of the central portion of the housing (Fig. 1, button 32), wherein said at least one click button is positioned on the front side in a position capable of being manipulated by fingers of the user's hand and a rear side of the central portion is contoured to a palm portion of the user's hand (Fig. 7 shows such an arrangement); a cursor control device being integrally positioned within the upper portion of the housing (Fig. 8, trackball 40), wherein said cursor control device is positioned within the upper portion of the housing in a position capable of being manipulated by a thumb of the user's hand (Fig. 7); and at least one programmable

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button being mounted on an upper face of the upper portion of the housing (Fig. 8, button 34).

However, Holmes does not teach a base docking station, wherein said base docking station is contoured to receive and integrally fit with the hand-held ergonomic data input and control device; and a lower portion contoured to integrally fit within said base docking station.

However, Robinson does teach a base docking station (Fig. 1, station 16), wherein said base docking station is contoured to receive and integrally fit with the hand-held data input and control device (Fig. 1, device 14, also see col. 2, lines 59-63) and a lower portion contoured to integrally fit within said base docking station (Fig. 1, where the lower portion of device 14 is contoured to fit the docking station 16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Robinson in the device of Holmes in order to have a portable base station that can recharge the power supply of a portable input and control device.

Regarding claim 18, Robinson further teaches a base docking station that further includes at least one of a click button, a programmable button, a scroll wheel, a trackball, a sensing device, a power supply, and a power supply charging device (see col. 2, lines 59-60, where the base docking station acts a power supply charging device).

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Tiphane et al. (US 7, 061,468) (hereafter, "Tiphane").

Regarding claim 12, Holmes teaches the limitations of claim 1 as discussed above, however Holmes does not teach a device further comprising a laser pointer.

However, Tiphane does teach a portable computer input device that further comprises a laser pointer (Fig. 1B, 120, see col. 3, lines 60-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the laser pointer of Tiphane in the device of Holmes in order to have the capability of pointing to a screen during a presentation.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Rosenberg, in further view of Pejic, and further in view of Robinson.

Regarding claim 14, Holmes in view of Rosenberg, and in further view of Pejic teaches the limitations of claim 13 as discussed above, however it does not teach the external host computing device including a base docking station, wherein said base docking station is contoured to receive and integrally fit with the lower portion of the housing.

However, Robinson does teach an external host computing (device (Fig. 1, where the external host computing device can consist of the combination of system 10, station 12, and station 16) including a base docking station (Fig. 1, station 16), wherein said base docking station is contoured to receive and integrally fit with the hand-held

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data input and control device (Fig. 1, device 14, also see col. 2, lines 59-63) and a lower portion contoured to integrally fit within said base docking station (Fig. 1, where the lower portion of device 14 is contoured to fit the docking station 16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Robinson in the device of Holmes in view of Rosenberg, and in further view of Pejic, in order to have a portable base station that can recharge the power supply of a portable input and control device.

15. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Young (US 6,419,519).

Regarding claim 16, Holmes teaches the limitations of claim 15 as discussed above, and Holmes further teaches a connector (Fig. 5, socket 48) mounted on a bottom, front face of lower portion of the housing (see col. 5, lines 4-10, where a bottom face extends in the perpendicularly in the ‘front’ direction) and being connected to a wire to communicate input and control data to the external host computing device (see col. 5, lines 4-10). However, Holmes does not teach using a pivoting connector.

However, Young does teach using a pivoting connector for electrical connectors (Figs. 4-7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Young in the connector of Holmes in order to have a connector that reduces strain on the wire.

Regarding claim 17, Holmes further teaches a device where a sensing device is a radio-frequency sensor (see col. 4, line 65 to col. 5 line 2).

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kikinis (US 5,841,424) teaches a docking station for multiple input devices. Young (US 20030142074) teaches a control device with a trackball, and buttons on the upper side and front side. Aoyagi et al. (US 5,694,153) teaches a stationary joystick with a topside cursor control device attached to a base station.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameer K. Gokhale whose telephone number is (571) 272-5553. The examiner can normally be reached on M-F 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SKG  
July 7, 2006

Sameer Gokhale  
Examiner  
Art Unit 2629

AMR A. AWAD  
PRIMARY EXAMINER

